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Docket No.: 1793.1114

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Serafim BOCHKAREV et al.

Serial No. 10/772,285

Group Art Unit: 2194

Confirmation No. 4961

Filed: February 6, 2004

Examiner: Van H. Nguyen

For: METHOD AND APPARATUS FOR DISPLAYING A DIALOGUE WINDOW OF A
DEVICE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed July 28, 2008, having a shortened period for response set to expire on August 28, 2008. The following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I, including claims 1-8.

II. Applicants Traverse the Requirement

Insofar as Groups I and II are concerned, it is believed that all claims 1-12, are so closely related that they should remain in the same application. In addition, it is further respectfully submitted that the differences between the Office Action indicated sub-combinations are not sufficient to warrant the restriction requirement.

MPEP § 803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05-806.05(i)); **and** (B) indicates that there must be a serious burden on the Examiner in order for restriction to be properly required (see MPEP §§ 803, 806.04(a)-806.04(i), 808.01(a) and 808.02).

A. The Office Action fails to demonstrate that the inventions are independent or distinct

While the Office Action has concluded that Groups I and II are independent or distinct, there is no evidence in the record supporting the assertion. For example, the Office Action merely concludes at page 2 that "Inventions I and II are related as subcombinations disclosed as

usable together in a single combination.” The Office Action then cites a theoretical rationale to support such a conclusion, without any explanation as to how such a rationale applies in the current matter. For example, the Office Action merely states at page 2 that “[t]he subcombinations are distinct from each other if they are shown to be separately usable.”

It is respectfully submitted that a mere assertion of a theoretically available rationale is insufficient and fails to meet the requirements under MPEP § 803. There must be some relatedness and explanation as to how the particular claims/groups meet one of the recited categories. For example, the Office Action must demonstrate how the asserted sub-combinations are separately usable. This is particularly important in the present case where the Office has issued three Office Actions without previously making such an indication.

B. The Office Action fails to show that examination of all the claims would pose a serious burden

There is no evidence in the record supporting the assertion that examination of all of the claims in the application cannot be made without serious burden.

Here, the Office Action merely cites two different subclasses that would allegedly need to be searched if the application were not restricted (i.e., class 719, sub-classes 321 and 327, respectively). However, it is respectfully submitted that all subclasses will need to be searched for any of the claims in Groups I or II. For example, Applicant refers to the Search Notes compiled for two previous search performed by the Examiner for the present application on November 29, 2006 and December 5, 2007. There, the Examiner indicates that sub-classes 321, 322 and 323 of class 719 were searched for each of the claims. Thus, there cannot be a serious burden for performing a search of sub-class 321 since the search must be performed for each of the alleged sub-combinations anyway. Moreover, there is no indication that the Examiner searched subclass 327 at all in either of the two previous searches.

Further, merely because different subclasses have been cited is not sufficient evidence in the record that a search of the same will be a serious burden. Again, as noted above, multiple subclasses will need to be searched for both groups of claims.

Finally, regarding the required serious burden criteria, it is respectfully submitted that the Examiner has not set forth any particular evidence in the record supporting the stated conclusion of a serious burden and different searches.

It is respectfully submitted that such a conclusion is improper and the Restriction requirement thus fails to meet the prima facie case for Restriction, i.e., additional evidence is required to maintain the Restriction requirement other than just the Examiner's conclusion.

III. Conclusion

Thus, it is respectfully submitted that the outstanding restriction requirement is improper and all claims should be maintained under review.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: August 28, 2008

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